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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,692	06/24/2002	Mark Pines	CO7-7	9383
7590 01/26/2004			EXAMINER	
D Graeser The Polkinghorns 9003 Florin Way Upper Marlboro, MD 20772			KIM, VICKIE Y	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,692

Applicant(s)

PINES ET AL.

Examiner

Vickie Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Election acknowledged

Applicants' election without traverse the group III (claims 12-17) is acknowledged. The election was made without traverse. Therefore, the restriction requirement deems to be proper and maintained, and made FINAL.

Claims 1-18 are now pending. The elected claims 12-17 are presented for the examination and the claims 1-11 and 18 are withdrawn from further consideration as being non-elected. The following rejections are made.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over pines et al(WO98/34617).

The claims are drawn to a method for treating a stricture comprising administering an effective amount of a compound of formula(claim 12).

Pines et al(WO'617 hereafter) teach a method of inhibiting adhesion formation, inhibiting scar formation, and promoting wound healing, wherein said method comprising administering a halofuginone compound. The halofuginone compound of formula(patented) is same compound required by the instant claims, see patented claims, abstract and pages 12-13.

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Applicant's claims differ because they specifically require a stricture.

However, it would have been obvious to one of ordinary skill in the art to extend the teaching of WO'617 to apply the patented halofuginone compound to stricture at the time of the invention was made because stricture is a form of scar as evidenced by applicant's own admission(see instant specification at page 1). Stricture is a medical term describing the condition of abnormal narrowing of a bodily canal or passageway due to the scar formation. As learned from WO'617, inhibition of scar formation would treat the formation of stricture.

As to claims 13-17, WO617 teaches inhibition of scar formation in various organs including not only abdominal cavity but also kidney, skin, lung, liver and so on. It also teaches the adhesion(scar) formation is occurred after surgical procedures, see page . Thus, one would have envisioned the successful treatment of the urethral structure, well within the scope of the patented invention and thus, obvious, absent evidence to the contrary.

Thus, one would have been motivated to do so because the effectiveness against adhesion(scar) formation and promoting wound healing using the halofuginone compounds is proven. One would have been motivated to apply said application to treat the stricture as well, with reasonable expectation of success, because all these said pathological processes are prevent by preventing collagen deposition from occurring within the wound space. Providing assurance is most desirable quality for successful outcome, a most critical factor to improve patient compliance and satisfaction.

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Thus, one would have been motivated to modify the teaching of the cited reference because they are drawn to same technical fields (constituted with same ingredients and share common utilities, and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

Conclusion

3. No claim is allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 703-305-1675. The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3165 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Vickie Kim,
Primary Patent Examiner
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